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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/281,809	03/31/1999	BO LIU	197/K38-1142	7664

7590

06/19/2002

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EXAMINER

GRENDZYNSKI, MICHAEL E

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 06/19/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/281,809

Applicant(s)

LIU ET AL.

Examiner

Michael E. Grendzynski

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-18 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-5, 7-18 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/28/02 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

2. Claims 1-5, 7-16, 18 and 23-26 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto in view of Asano for the reasons of record. Applicants argue that the proffered evidence distinguishes the instant invention over the prior art because it demonstrates unexpected results. Examiner has carefully considered the evidence, but it does not distinguish the instant invention over the prior art. In the ink-receiving layer of Example 1, applicants use the identical binder, silica and cationic resin as those disclosed in the Miyamoto and Asano references. The ink-receiving layer, moreover, possesses a peak pore volume within the amount claimed by applicants. That is, the ink-receiving layer of Comparative Example III comprises the *identical* compounds of Example I, all present in the same amounts. However, the results obtained from these two Examples differ. What causes this difference? It is the examiner's position that critical subject matter is not present in the claims which provides for this difference. Does a structural difference provide the results? The only difference structurally between the materials of the Examples is that the structure of Comparative Example III includes a substrate comprising polyethylene terephthalate film, while the structure of Example 1 includes a substrate comprising coated paper. This difference, however, is not claimed. Miyamoto, moreover, discloses that its support may comprise paper. *See* col. 6, ll 47-63. For these reasons, the rejection of Claims 1-5, 7-16, 18 and 23-26 under 35 U.S.C. 103(a) is maintained.

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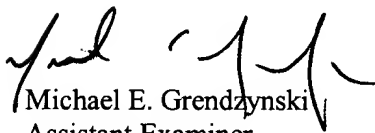
3. For similar reasons, claim 17 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto in view of Asano (as applied to claims 1-5, 7-16, 18 and 23-26) in view of the Snowtex® Product Bulletin.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.


Michael E. Grendzynski
Assistant Examiner
June 13, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

